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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,209	09/24/2003	Hiroshi Hasegawa	243209US2SRD	1604
22850	7590	06/21/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			ANGEBRANNDT, MARTIN J	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1756

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,209	HASEGAWA, HIROSHI	
	Examiner	Art Unit	
	Martin J. Angebranndt	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/23/04, 3/9/06, 8/31/05 & 9/24/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/9/06, 9/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“the non-recording zone is used as a recording zone” is non-sensible. The applicant may be trying to indicate that there is a test area for determining the characteristics of the recording layer, rather than user data. Please clarify the claim.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Yamamoto et al. '560.

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Yamamoto et al. '560 describes with respect to figure 4, the preformatted areas (5) in the first recording layer (11), the spacer (15) and a second recording layer (12) with preformatted areas and guard areas(14). The first and second recording areas are phase change recording layers (4/45-5/19). The data in the preformatted areas is recorded as embossed information relating to addresses and the like, with lands and grooves being formed in the recording areas. (2/22-29).

Currently the claims read on the media bearing two phase change recording layers in **conventional formats** (ie pre-pits in the lead-in area). With respect to claims 6 and 7, without the medium being a recorded medium with this information recorded in it, these are intended use limitations.

The examiner notes that the specification does not even describe the structure/composition of the non-recording/non-erasure area, thus limiting the ability of the applicant to add limitations to obviate any prior art rejections by limiting it to a hybrid structure or the like where the recording layer composition is not provided in the lead in or lead-out areas.

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. '560.

With respect to claim 9, the location of the addresses for specific sectors or the like (as in claim 9) is not considered to provide patentable definition as long as the information is present and is considered a mere design choice and the examiner holds that the placement of specific data in any of various specific locations in a recording medium compatible with conventional formats would have been obvious to one skilled in the art.

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7. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohsawa et al. '781.

Ohsawa et al. '781 teaches recording layers where each recording layer is provided with a writeable AgInTeSb recording layer and a prepit region composed of embossed pits which carry addresses, timing information etc. (6/12-64). Address information may be in both layers (5/10-17). The address information can be formed in the inner or outer periphery (5/18-25). The recording of all the address/predetermined/TOC information for the medium in the deepest layer is disclosed. (5/33-67).

It is not clear, if the embodiment described in column 6 has the address areas overlapping. The examiner holds that this is anticipated at the embodiment where both are in the lead-in areas (inner periphery) of the respective recording layers is immediately envisioned when reading the reference as this is the only location described. Alternatively, if this position is not upheld, the examiner holds that it would have been obvious to one skilled in the art to form the recording medium described in column 6 with the pre-pit areas for each of the layers are provided in the lead-in areas and therefore they overlap.

8. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Tsumagari et al., '057.

The description of a multilayered recording medium is provided with respect to figure 1. The case where both recording layers are phase change recording media and have data recording area (28), lead-in area (27) and a leadout area (26). (6/8-39). The lead in areas include embossed information relating to the disk, such as size, recording density, addresses and the like and a

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rewritable zone such as recording a disc name, a test recording area and a field for keeping track of damaged area. (8/25-9/46).

9. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumagari et al., '057.

With respect to claim 9, the location of the addresses for specific sectors or the like (as in claim 9) is not considered to provide patentable definition as long as the information is present and is considered a mere design choice and the examiner holds that the placement of specific data in any of various specific locations in a recording medium compatible with conventional formats would have been obvious to one skilled in the art.

10. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Ohsawa et al. '231.

See the description with respect to figure 4, which describes plural rewritable layers each with an embossed lead in area. (4/60-5/19).

11. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Nakamura et al. WO 00/79525 (US 2005/0259561 is English equivalent)

See the description with respect to figure 34, which describes plural rewritable layers learning areas (3401,3404). (37/20-38/7, [0285-0291] in US prepub) The discussion with respect to figure 30 describes the embossed lead in area. (35/2-15, [0268-0270] in US prepub)

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Woudenberg '602 see [0035].

Narumi et al. '121 is cumulative to references used in the above rejections.

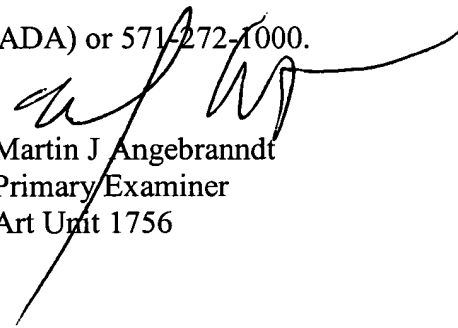
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Watase '549 and Wang et al. '993 teach hybrid type media.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J. Angebranndt
Primary Examiner
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06/14/2006